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10/606,825

06/26/2003

Raymond Neff

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04/18/2008

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EXAMINER

COONEY, JOHN M

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/606,825  
Filing Date: June 26, 2003  
Appellant(s): NEFF ET AL.

Kristopher Hulliberger  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 1-22-08 appealing from the Office action mailed 7-26-07.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**WITHDRAWN REJECTIONS**

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The rejections under 35 USC 103 over Hager et al. and Bleys are withdrawn.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

5,420,170

LUTTER ET AL.

5-1995

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 4, 5, 7-18, 20-25, 28, 29, 31-41, 43-48, 51, 52, and 54-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lutter et al.(5,420,170).

Lutter et al. discloses preparations of polyurethane foams having densities as claimed prepared from isocyanates, polyols as defined by applicants' claims, chain extenders in amounts in overlap with those claimed, extenders reading on the crosslinkers as claimed, and other auxiliaries, regulators, and additives which are mixed and reacted at isocyanate indices as claimed (see column 4 lines 10-44, column 8 line 50-column 11 line 36, column 12 lines 51-64, column 13 lines 19-26, and the examples, as well as, the entire document). The ranges of tan delta peak and glass transition values of applicants' claims are held to be values intrinsic to the make-up of the polymer formed and materials used in their formation, and operation within the ranges of

material controls provided for by Lutter et al. would lead on of ordinary skill in the art to expect formation of articles having the properties as claimed.

Lutter et al. differs from appellants' claims in that chain extenders are not particularly employed in amounts as claimed. However, Lutter et al. recites control in the amounts of chain extender employed in the preparation of useable products embodied by their disclosure (see again column 9 lines 15-21). Accordingly, it would have been obvious for one having ordinary skill in the art to have varied the amounts of chain extender employed within the teachings of Lutter et al. for the purpose of controlling and extending polymer build-up in the products obtained in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results. It has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of the same properties. *Titanium Metals v Banner* 227 USPQ 773. **(see also MPEP 2144.05 I)** Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215 (CCPA 1980).

### **(10) Response to Argument**

Appellants' arguments have been considered. However, rejection is maintained. Examiner maintains that when considering showings of new or unexpected results, the following must be considered:

#### **Results Must be Unexpected:**

Unexpected properties must be more significant than expected properties to rebut a prima facie case of obviousness. *In re Nolan* 193 USPQ 641 CCPA 1977.

Obviousness does not require absolute predictability. *In re Miegel* 159 USPQ 716.

Since unexpected results are by definition unpredictable, evidence presented in comparative showings must be clear and convincing. *In re Lohr* 137 USPQ 548.

In determining patentability, the weight of the actual evidence of unobviousness presented must be balanced against the weight of obviousness of record. *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *In re Beattie*, 24 USPQ 2d 1040.

#### **Claims Must be Commensurate With Showings:**

Evidence of superiority must pertain to the full extent of the subject matter being claimed. *In re Ackerman*, 170 USPQ 340; *In re Chupp*, 2 USPQ 2d 1437; *In re Murch* 175 USPQ 89; *Ex Parte A*, 17 USPQ 2d 1719; accordingly, it has been held that to overcome a reasonable case of prima facie obviousness a given claim must be commensurate in scope with any showing of unexpected results. *In re Greenfield*, 197

USPQ 227. Further, a limited showing of criticality is insufficient to support a broadly claimed range. *In re Lemin*, 161 USPQ 288. See also *In re Kulling*, 14 USPQ 2d 1056.

Appellants' arguments and declaration evidence have been considered but are insufficient in that they do not provide definitive and factually supported showings of new or unexpected results attributable to their compositions as claimed based on differences in their claims that are commensurate in scope with the scope of the claims as they currently stand.

Lutter et al. provides for good foam articles having good viscoelastic and structure-borne soundproofing properties (see again column 13 lines 26-34) not distinguishable from the products of appellants' claims based on the ranges of property values identified by appellants' claims. Appellants' limited comparison based on the modification of a selected exemplified composition of Lutter et al. is insufficient in overcoming the current evidence of obviousness provided for by the teachings of Lutter et al. Additionally, appellants' comparison presented in the declaration and other disclosures are insufficient and not commensurate in their representation of the scope of their claims,

Further, it is noted that even the exemplified embodiments of Lutter et al. pointed to by appellants' arguments at page 19 lines 5 correlate to glass transition values within the ranges of values of appellants' claims. This further demonstrates the intrinsic correlation between the viscoelastic, structure-borne soundproofing properties

discussed by Lutter et al. and the glass transition and other dynamic mechanical strength (tan delta peak) values of appellants' claims.

Examiner maintains Lutter et al. to be sufficient in its fair suggestion of control of amounts of chain extenders as claimed by appellants in compositions of the instant concern. The opinions set forth by Dr. Neff and the other evidence of record are insufficient in demonstrating clear and convincing showings of new or unexpected results associated with the differences in their claims that are also commensurate in scope with the scope of their claims. Further, it is held and maintained that Dr. Neff's opinions and the limited showings of record are insufficient in demonstrating that rejection based on the evidence of expected results and properties provided for by what is taught and fairly suggested by Lutter et al.'s fully considered disclosure.

No substantive arguments pertaining to the rejection over Lutter et al. are made specific to claims 4,5,7-18, and 20-24. Accordingly, no further arguments specific to these claims are necessary.

Appellants' arguments pertaining to claim 48 are predominately a reiteration of the arguments made in reference to claim 1, and, accordingly, examiner reiterates the arguments made in reference to claim 1. Appellants' arguments pertaining to claim 48 do differ from their arguments pertaining to claim 1 in that they point out the isocyanate index values in their arguments pertaining claim 48. On this point, it is noted and reiterated that these values of appellants' claims are not a distinguishing feature over the teachings of Lutter et al. (see again column 12 lines 51-64).



Appellants have not persuasively demonstrated a clear and convincing showing of new or unexpected results associated with the differences in their claims which are commensurate in scope with the scope of their claims. Appellants have not demonstrated their results to be clearly and convincingly unexpected and more than mere optimizations of the knowledge in the art or more significant than being secondary in nature. Additionally, examiner holds and maintains that the evidence of record does not clearly and convincingly establish that the evidence of new or unexpected results is more significant than the evidence of expected results.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

John M. Cooney, Jr.

/John Cooney/

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